

REMARKS

Claims 79-82 and 85-92 are pending in this application.

Claims 79-82 and 85-92 stand rejected under 35 U.S.C. § 102(e) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Xing et al., U.S. Patent No. 6,090,697 (hereinafter "Xing"). Applicants respectfully traverse the rejection and request reconsideration.

Contrary to the Office Action's position, the limitation "oxygen annealed photo-decomposed platinum group metal film" is not a product-by-process limitation, but rather a *resulting structure* having distinct and defined characteristics. The term "oxygen annealed photo-decomposed platinum group metal film" describes the physical characteristics of the first or second electrodes in claim 79. The term "oxygen annealed photo-decomposed platinum group metal film" is a limitation of the first or second electrode, and not words descriptive of a process forming the first or second electrode.

Claim limitations which confer distinct and defined characteristics of a structure have been analyzed by the Federal Circuit in Hazani v. U.S. Int'l Trade Comm'n, for example, which involved patent claims to a memory cell comprising a conductive plate having a surface that was "chemically engraved." Hazani v. U.S. Int'l Trade Comm'n, 126 F.3d 1473, 44 USPQ2d 1358 (Fed. Cir. 1997). In Hazani, the Federal Circuit specifically emphasized that the claims were "pure product claims" and not product-by-process claims. In arriving at this conclusion, the Federal Circuit reasoned that "Hazani argues that the 'chemically engraved' claims are product-by-process claims. We agree with the respondents, however, that those claims are best characterized as pure product claims, since the 'chemically engraved' limitation, read in

context, describes the product more by its structure than by the process used to obtain it.” Id.

In view of Hazani, the limitation “oxygen annealed photo-decomposed platinum group metal film” of claim 79 can only be a structural limitation and not a product-by-process limitation. An “oxygen annealed photo-decomposed platinum group metal film,” like the “chemically engraved” plate of Hazani, is a *resulting structure* having distinct and defined characteristics and not a product formed by a particular process.

Even assuming that the claim limitations of claims 79-82 and 85-92 are product-by-process limitations, “[t]he structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.” MPEP § 2113 (citing *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979)).

Application No.: 09/594,171

Docket No.: M4065.0132/P132-A

Since Xing et al. fails to teach or suggest the "oxygen annealed photo-decomposed platinum group metal film" limitation, all claims are in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: September 22, 2003

Respectfully submitted,

By 

Thomas J. D'Amico

Registration No.: 28,371

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

2101 L Street NW

Washington, DC 20037-1526

(202) 785-9700

Attorney for Applicant